

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant :	Donald F. Hamilton et al.	Art Unit :	2614
Serial No. :	08/777,958	Examiner :	Ping Lee
Filed :	December 24, 1996	Conf. No. :	4029
Title :	VEHICLE TRUNK WOOFER		

Mail Stop Appeal Brief - Patents

Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF FOR APPELLANT

I. THE RULING BY THE BOARD OF PATENT APPEALS AND INTERFERENCES THAT THE APPLICATION MEETS THE ENABLING REQUIREMENT AND SUPPORTS A CONCLUSION THAT THE CLAIMS MEET THE WRITTEN DESCRIPTION REQUIREMENT

The Examiner's Answer states:

Claims 1, 3-6 and 8-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claimed limitation in the instant application "said at least one speaker is disposed in a rearward section of the trunk occupying negligible useful trunk volume to cause a smaller decrease in calculated trunk volume than would occur with said at least one speaker mounted in said rear deck" is specified in lines 8-10 of claim 1. The original specification (which was filed on 4/21/92) of the current application discloses that "the speakers mounted in the rear deck reduce the calculated trunk volume of the vehicle" on lines 16-17 of p. 1, and "the enclosure in the corner of the trunk results in a smaller decrease in calculated useful trunk volume than do speakers mounted in the rear deck" on lines 22-25 of p. 2. Accordingly, the original specification (which was filed on 4/21/92) of the current application and the original drawing (which was filed on 4/21/92) of the current application only disclose how to compare the calculated useful trunk volume between speakers (plural) being mounted on the rear deck and the speaker being disposed in the trunk clear of the rear deck above the trunk floor and outside of the spare tire compartment, but fails to disclose how to compare the calculated useful trunk volume with one speaker (singular) being mounted in the rear deck and the speaker being disposed in the trunk clear of the rear deck above the trunk floor and outside of the spare tire compartment. Therefore, claim 1 introduces

new matter which was not described in the specification as originally filed. PP. 3-4.

That we have shown in our brief how the language in the prior decision of the Board of Patent Appeals and Interferences finding that this application meets the enabling requirements of 35 U.S.C. §112, first paragraph, also supports a conclusion that the written description requirement has been met. Amended Fifth Appeal Brief (5th Br.), pp. 3-4. The written description including the drawing that is sufficient to enable those skilled in the art how to practice the invention manifestly discloses that appellant had possession of the claimed invention at the time this application was filed.

II. THE EXAMINER HAS NOT PROPERLY CONSTRUCTED THE CLAIMS AS ONE OF ORDINARY SKILL IN THE ART WOULD INTERPRET THE CLAIMS IN THE LIGHT OF THE SPECIFICATION CALLING FOR THE AT LEAST ONE SPEAKER DISPOSED IN A REARWARD SECTION OF THE TRUNK OCCUPYING NEGLIGIBLE USEFUL TRUNK VOLUME TO CAUSE A SMALLER DECREASE IN CALCULATED TRUNK VOLUME THAN WOULD OCCUR WITH THE AT LEAST ONE SPEAKER MOUNTED IN THE REAR DECK

The pertinence of the specification to claim construction is reinforced by the manner in which a patent is issued. The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Acad. Of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). *Phillips v. AWH Corp.*, 75 U.S.P.Q. 1321, 1329 (Fed. Cir. 2005) (en banc).

The claims call for the speaker being "disposed in a rearward section of the trunk occupying negligible useful trunk volume than would occur with said at least one speaker mounted ins aid rear deck."

The specification discloses:

With reference now to the drawings and more particularly FIG. 1, a speaker enclosure 9 is placed in a rearward section of the trunk 7 of the vehicle 1 above the trunk floor 8 and outside any compartment containing the spare tire. The speaker enclosure 9 is not, however, mounted to the rear deck 3 nor are speaker holes provided in the rear deck. As shown in the rear view of FIG. 2, placement of the speaker enclosure 9 is preferably in a corner of the vehicle trunk 7 (here the left corner) occupying negligible useful trunk volume. P. 2, lines 13-21.

FIGS. 1 and 2 clearly show the small enclosure 9 in a corner of the vehicle trunk occupying negligible useful trunk volume.

Manifestly, FIG. 5 of the Hathaway reference fails to disclose anything resembling such claimed structure or remotely suggesting how to modify that large disclosed structure so that it would occupy negligible trunk volume.

We stand on the position and authorities set forth in our brief. 5th Br. 5-14. Properly constructing the claims as would be interpreted by one of ordinary skill in the art in the light of the specification requires a conclusion that the references, like those previously advanced in prior appeals, fail to make obvious the subject matter as a whole of the invention disclosed and claimed in this application.

Respectfully submitted,
FISH & RICHARDSON P.C.

10 September 2009
Date: _____

/charles hieken/

Charles Hieken
Reg. No. 18,411
Attorneys for Application Owner

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (877) 769-7945